

ESTTA Tracking number: **ESTTA321569**

Filing date: **12/11/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	OXFORD 2005 HOLDINGS, LLC		
Entity	limited liability company	Citizenship	Colorado
Address	1575 Welton Suite 300 Denver, CO 80202 UNITED STATES		

Attorney information	Ellen Reilly The Reilly Intellectual Property Law Firm, P.C. 1325 East 16th Avenue Denver, CO 80218 UNITED STATES reilly@iplawdenver.com Phone:303-839-8700
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### Registrations Subject to Cancellation

Registration No	3076626	Registration date	04/04/2006
Registrant	Baney Corporation 1550 NE Williamson Blvd. Bend, OR 97701 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 043. First Use: 1998/01/01 First Use In Commerce: 1998/01/01 All goods and services in the class are cancelled, namely: Hotel services for providing temporary lodging accomodations
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### Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)		
Priority and likelihood of confusion	Trademark Act section 2(d)		
Dilution	Trademark Act section 43(c)		
Registration No	3076619	Registration date	04/04/2006
Registrant	Baney Corporation 1550 NE Williamson BLVD Bend, OR 97701 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 043. First Use: 1989/07/01 First Use In Commerce: 1989/07/01 All goods and services in the class are cancelled, namely: Hotel services for providing temporary lodging accomodation
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## Grounds for Cancellation

False suggestion of a connection		Trademark Act section 2(a)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Dilution		Trademark Act section 43(c)	
Registration No	3600199	Registration date	03/31/2009
Registrant	Baney Corporation 1550 NE WILLIAMSON BLVD BEND, OR 97701 UNITED STATES		


## Goods/Services Subject to Cancellation

Class 043. First Use: 2006/09/30 First Use In Commerce: 2006/09/30  
All goods and services in the class are cancelled, namely: Hotel services for providing temporary accommodation to guests


## Grounds for Cancellation

False suggestion of a connection		Trademark Act section 2(a)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Dilution		Trademark Act section 43(c)	

## Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77558889	Application Date	08/29/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE OXFORD HOTEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1891/10/03 First Use In Commerce: 1891/10/03 Hotel Services		

U.S. Application No.	77561757	Application Date	09/03/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OH THE OXFORD HOTEL		

Design Mark	
Description of Mark	The mark consists of the overlaid letters "OH" above the wording "The Oxford Hotel".
Goods/Services	Class 043. First use: First Use: 1891/10/03 First Use In Commerce: 1891/10/03 Hotel and restaurant services
Attachments	77558889#TMSN.jpeg ( 1 page )( bytes ) 77561757#TMSN.jpeg ( 1 page )( bytes ) Executed Petition for Cancellation.pdf ( 7 pages )(155122 bytes )

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ellen reilly/
Name	Ellen Reilly
Date	12/11/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re* Registration No. 3,076,619  
Registered: April 4, 2006  
For: OXFORD SUITES

*In re* Registration No. 3,076,626  
Registered: April 4, 2006  
For: OXFORD INN & SUITES

*In re* Registration No. 3,600,199  
Registered: March 31, 2009  
For: OXFORD HOTELS

OXFORD 2005 HOLDINGS, LLC

Petitioner,

vs.

BANEY CORPORATION

Registrant

Cancellation No. \_\_\_\_\_

PETITION FOR CANCELLATION

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
Post Office Box 1451  
Alexandria, Virginia 22313-1451

Dear Sir or Madam:

OXFORD 2005 HOLDINGS, LLC (“Petitioner”), a Colorado limited liability company, located and doing business at 1575 Welton, Suite 300, Denver, Colorado 80202, believes that it will be damaged by the continued registration of the marks “OXFORD SUITES” shown in Registration No. 3,076,619, “OXFORD INN & SUITES”

shown in Registration No. 3,076,626, and “OXFORD HOTELS” shown in Registration No. 3,600,199, all owned by BANEY CORPORATION (“Registrant”), an Oregon corporation with a mailing address of 1550 NE Williamson Boulevard, Bend, Oregon 97701, and hereby petitions for cancellation of same.

As grounds for cancellation, Petitioner alleges:

1. Petitioner is the owner of Serial No. 77/558,889 for THE OXFORD HOTEL for “hotel services” in Class 43. Petitioner’s application for said registration was filed on August 29, 2008 and is currently pending. Petitioner and its predecessors-in-interest, subsidiaries, affiliates and/or licensees have used the mark THE OXFORD HOTEL on and in connection with hotel services for more than one hundred eighteen years.

2. Petitioner is also the owner of Serial No. 77/561,757 for THE OXFORD HOTEL & DESIGN for “hotel services” in Class 43. Petitioner’s application for said registration was filed on September 3, 2008 and is currently pending. Petitioner has used the mark THE OXFORD HOTEL & DESIGN on and in connection with hotel services for more than one hundred eighteen years.

3. The marks referred to hereinabove will be hereafter collectively referred to as Petitioner’s Marks.

4. By virtue of Petitioner's extensive use and promotion of Petitioner's Marks, Petitioner has established valuable goodwill in the marks, and the public has come to associate the "OXFORD" marks with the Petitioner. As such, the public has come to know "OXFORD" as an indication of hotel services that originate from Petitioner.

5. By virtue of long use of Petitioner's Marks, and the high quality of services rendered under the marks, the Petitioner's Marks have achieved the status of famous marks.

6. Petitioner's hotel was founded in Denver in 1891 and continues to operate as a well-known hotel. On the actual filing date of its application, Registrant had constructive notice of ownership of Petitioner's Marks and had knowledge, or upon reasonable inquiry would have had knowledge and therefore had constructive knowledge, if not actual knowledge, of the fame of Petitioner's Marks in connection with its services.

7. Registrant's application for OXFORD SUITES proceeded to registration on April 4, 2006. The resultant registration, U.S. Trademark Registration No. 3,076,619 (the "Registration"), is the subject of this proceeding.

8. Registrant's application for OXFORD INN & SUITES proceeded to registration on April 4, 2006. The resultant registration, U.S. Trademark Registration No. 3,076,626 (the "Registration"), is the subject of this proceeding.

9. Registrant's application for OXFORD HOTELS proceeded to registration on March 31, 2009. The resultant registration, U.S. Trademark Registration No. 3,600,199 (the "Registration"), is the subject of this proceeding.

10. Petitioner's Marks were in use and had become famous before Registrant began use of their marks.

11. Registrant's services, as described in their Registrations, are closely related to the services identified in Petitioner's applications.

12. As a result of the similarity between Petitioner's Marks and Registrant's marks for "OXFORD INN & SUITES", "OXFORD SUITES" and "OXFORD HOTELS" and the highly related nature of the services associated with each party's respective marks, Registrant's marks are likely to cause confusion, mistake or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties' respective services.

13. The continued registration of the marks in the Registrations and use of Registrant's marks are likely to dilute Petitioner's famous Marks as expressed in Section 43(c)(1) of the Trademark Act.

14. The continued registration of the marks in the Registrations will result in damage to Petitioner under the provisions of 15 U.S.C. § 1052(d) and 15 U.S.C. § 1125(c), pursuant to the allegations stated above.

15. The continued registration of the marks in the Registrations will cause confusion among consumers as to the separate and distinct sources of Registrant's services and Petitioner's services and the relationship of Petitioner to Registrant, thereby damaging Petitioner's goodwill in Petitioner's Marks, diluting the value thereof, and resulting in irreparable harm to Petitioner's business and reputation, all to the detriment of Petitioner who has expended considerable sums and effort in promotion of Petitioner's Marks for well over a century.

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted and that U.S. Trademark Registration Nos. 3,076,626, 3,076,619 and 3,600,199 be canceled.

Please charge any necessary fee regarding this Petition to the Deposit Account of The Reilly Intellectual Property Law Firm, P.C., 18-0875, and credit any overpayment to such deposit account.



Please direct all notices, pleadings and process regarding this matter to:

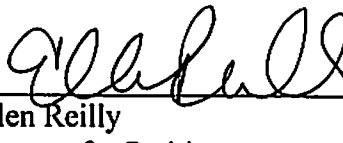
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Respectfully submitted,

The Reilly Intellectual Property Law Firm, P.C.

Dated: December 11, 2009

By

A handwritten signature in black ink, appearing to read 'Ellen Reilly', is written over a horizontal line.

Ellen Reilly  
Attorney for Petitioner

# CERTIFICATE OF SERVICE

I hereby certify that on December 11, 2009, I served a copy of the following document entitled PETITION FOR CANCELLATION on counsel for Registrant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Susan Daly Stearns, Esq.  
P.O. Box 215  
Bend, OR 97709

  
Julie Wiseman